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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,559	08/03/2001	Jon E. Beck	IOM-P022.01	1726

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EXAMINER

SIRMONS, KEVIN C

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,559

Applicant(s)

BECK ET AL.

Examiner

Kevin C. Sirmons

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-26, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-26, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: It is the Examiner's position that Applicant has evoked sixth paragraph, means-plus-function language to define Applicant's invention. Therefore the Examiner requires the Applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, and acts perform the function recited in the claim element. Please note that the MPEP clearly states, "Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to the means- (or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the PTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o)...". (Also see **MPEP 2181** (Rev. 1, Feb.2000))

As to claim 29, it is unclear what applicant regards as the means for biasing the medial and lateral straddling members. It appears that 24 and 26 are merely pointing to an opening.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 21, 24-26 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Morgan Re. 28,873.

Morgan discloses an ocular apparatus comprising: a housing member (22) configured to be at least partially placed beneath one of the upper and lower eyelids, and directly adjacent an eye of a patient; a medicament containment member associated with the housing (4); and at least one of: a lateral straddling member; and a medial straddling member (32); lateral and medial straddling members are each configured for direct insertion into, and cooperation with one of the corners of the eye of the patient to, in turn, register the placement of the housing member on the eye (fig. 1); as to claims 24-26, (fig. 1); as to claim 29 (16, 38).

Claims 21, 22-26 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by McClure U.S. Pat. No. 4,512,040.

McClure discloses an ocular apparatus comprising: a housing member (10) configured to be at least partially placed beneath one of the upper and lower eyelids, and directly adjacent an eye of a patient; a medicament containment member associated with the housing (20); and at least one of: a lateral straddling member (30); and a medial straddling member (28); lateral and medial straddling members are each configured for direct insertion into, and cooperation with one of the corners of the eye of the patient to, in turn, register the placement of the housing member on the eye (fig. 1); as to claims 22, (any portion of 28 and 30 other than the lateral and medial straddling member portions); as to claim 23, (any portion of 28 and 30 other than the aforementioned portions) 24-26, (fig. 1); as to claim 29 (fig. 1).

Claims 21 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Newsome U.S. Pat. No. 6,101,411.

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Newsome discloses an ocular apparatus comprising: a housing member (40) configured to be at least partially placed beneath one of the upper and lower eyelids, and directly adjacent an eye of a patient; a medicament containment member associated with the housing (40, col. 3, lines 59-67); and at least one of: a lateral straddling member (40); and a medial straddling member (40); lateral and medial straddling members are each configured for direct insertion into, and cooperation with one of the corners of the eye of the patient to, in turn, register the placement of the housing member on the eye (fig. 20) as to claim 30, (20).

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kevin C. Sirmons whose telephone number is (703) 306-5410. The examiner can normally be reached on Monday - Thursday from 6:30 am to 4:00 pm. The examiner can also be reached on alternate Fridays.

Kevin C. Sirmons

Kevin C. Sirmons
Patent Examiner
4/1/04